



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

HJ

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/645,503	08/22/2003	Hye Jeong Jeon	24286/81401	8746
7590	03/23/2006			
Peter H. Kang SIDLEY AUSTIN BROWN & WOOD LLP Suite 2000 555 California Street San Francisco, CA 94104-1715			EXAMINER	
			VAUGHN, GREGORY J	
			ART UNIT	PAPER NUMBER
			2178	
DATE MAILED: 03/23/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/645,503	JEON ET AL.	
	Examiner	Art Unit	
	Gregory J. Vaughn	2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 22 August 2003.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 12-15,20,22-62 and 64-70 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 12-15,20,22-62 and 64-70 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1.) Certified copies of the priority documents have been received.
 2.) Certified copies of the priority documents have been received in Application No. _____.
 3.) Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2/17/2005</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Action Background

1. This action is responsive to the application filing, application filed on 8/22/2003.
2. Acknowledgement is made to the applicant's submission of a Preliminary Amendment, filed 5/12/2004, wherein the specification was amended, claims 1-11 and 16-19 were canceled, and claims 20-70 were added.
3. Acknowledgement is made to the applicant's submission of a Preliminary Amendment, filed 3/8/2005, wherein claim 21 was canceled, and claims 12-15, 20, 22, 28, 36, 43, 50 and 64 were amended.
4. Claims 12-15, 20, 22-62 and 64-70 are pending in the case, claims 12, 20, 22, 28, 36, 43, 50, 57 and 64 are independent claims.
5. Acknowledgement is made to the applicant's submission of an Information Disclosure Statement, filed 2/17/2005.

Priority

6. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d) to Korean applications 49966/2002 (filed 8/23/2002) and 62827/2002 (filed 10/15/2002). The certified copies of these applications have been filed in the current application.

Specification

7. The amendment filed 5/12/2004 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: "*document contents such as a title, a summary and the like of a television program can generally be considered metadata.*"

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Objections

8. The preliminary amendment of 3/8/2005 is objected to because claim 63 is not listed, and claim 68 is listed twice. Appropriate action is requested. The examiner assumes claim 63 was canceled and the double listing of claim 68 is erroneous.

Claim Rejections - 35 USC § 112

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

"The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention."

10. Claims 12-15, 20, 22-62 and 64-70 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

11. **Regarding claims 12-15,** the amendment filed 3/8/2005 adds the following limitations: "*a metadata fragment related to a television program*", "*adding to-be-deleted fragment to the invalid element*" and "*the corresponding fragment contained in the invalid element are deleted*". The examiner has reviewed the originally filed specification, and has failed to find support for the added limitations. Applicant is required to cancel the new matter in response to this office action.

12. **Regarding new claim 20,** the amendment filed 3/8/2005 adds the following limitations: "*updating metadata fragment included in an electronic document*", "*a prescribed metadata fragment is stored at a client*", "*requesting an updated version of said prescribed metadata fragment to a provider*", "*said*

prescribed metadata fragment is an invalid fragment", "said prescribed metadata fragment is identified by a fragment identification" "deleting said prescribed metadata fragment notified as said invalid fragment from said client". The examiner has reviewed the originally filed specification, and has failed to find support for the added limitations. Applicant is required to cancel the new matter in response to this office action.

13. **Regarding new claims 22-62 and 64-70,** the claims are replete with new matter. Claims 22-62 and 64-70 are directed toward a method that incorporates an "*updating*" step. Although the originally filed disclosure mentions *updating* in the *Summary of the Invention* section of the disclosure (paragraphs 10 and 11), the *Detailed Description of Preferred Embodiments* section of the disclosure is silent with respect to *updating*. Also, claims 22-62 and 64-70 are directed toward a "*fragment*" of an electronic document, however the originally filed disclosure is silent with respect to a document fragment. Likewise, the terms "*metadata fragment*", "*invalid fragment*", "*to-be-deleted fragment*", "*corresponding fragment*", "*prescribed metadata fragment*", "*fragment identifier*", "*a fragment describing metadata*", "*updating a fragment*", "*deleting a fragment*", "*fragment is based on XML*", "*version of said fragment*" are not defined nor can they even be found in the disclosure. Furthermore, the term "*metadata*" is used in the claims, without support for the term in the disclosure. The examiner has reviewed the originally filed specification, and has failed to find support for the added limitations. Applicant is required to cancel the new matter in response to this office action.

14. Claims 12-15, 20, 22-62 and 63-70 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 12-15, 20, 22-62 and 63-70 use the term "*notified*" in a manner contrary to the ordinary meaning of the word, and the originally filed disclosure fails to define this term as it is used in the claims. For instance claim 12 recites: "*wherein deletion of said metadata fragment to said television program is notified by adding to-be-deleted fragment*". The context of the sentence indicates to the examiner that the meaning of the term "*notified*" must be similar to the terms "*completed*" or "*accomplished*". However, claim 20 uses the terms "*notifies*" and "*notified*" with apparently different meaning. The claim recites "*receiving an invalid element which notifies at least one version of said prescribed metadata fragment*". The examiner is not sure if the term "*notifies*" is used to mean "*modifies*" or "*to send notice*" (however, the disclosure fails to support either of these meanings). Claim 20 also recites "*deleting said prescribed metadata fragment notified as said invalid fragment*". Here, the meaning of the term "*notified*" seems to be directed toward "*identified*" or "*determined*". Applicant is required to clarify the meaning of these terms. Applicant is reminded that no new matter may be added.

Claim Rejections - 35 USC § 102

15. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

"A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language."

16. Claims 12-15, 20, 22-62 and 63-70 are rejected under 35 U.S.C. 102(e) as being anticipated by Abajian, US Patent 6,847,977, filed 6/11/2001, patented 1/25/2005.

17. **Regarding independent claim 12,** Abajian discloses supplying an electronic document based on XML. Abajian recites: "*Web page content includes HTML, XML, metatags, and any other text on the web page*" (column 4, lines 44-47). XML inherently uses a syntax defining a structure of the electronic document. Abajian discloses a document with an invalid element related to a television program. Abajian recites: "*In an exemplary embodiment of the invention, a streaming media file is retrieved and played to determine it is valid. If determined to be invalid (not successful in step 52), the Internet stream object is assigned a later time and priority*" (column 8 lines 17-22).

Abajian defines the Internet stream object as a television program. Abajian recites: "*Metadata may also be transmitted in a stream in parallel or as part of the stream used to transmit a media file (a High Definition television broadcast is transmitted on one stream and metadata, in the form of an electronic programming guide, is transmitted on a second stream)*" (column 4, lines 57-62). Abajian discloses deleting metadata related to a television program. Abajian recites: "*Promoter 82 adds, deletes, and/or updates the data (including metadata) associated with a media file in accordance with the requirements of the target search system*" (column 14, lines 64-66).

18. **Regarding dependent claim 13,** Abajian discloses an element identifier in the table shown in column 4 lines 35-43. Abajian discloses deleting as described above.
19. **Regarding dependent claim 14,** Abajian discloses deleting fragments of the corresponding document. Abajian recites: "*Promoter 82 adds, deletes, and/or updates the data (including metadata) associated with a media file in accordance with the requirements of the target search system*" (column 14, lines 64-66).
20. **Regarding dependent claim 15,** Abajian discloses invalid elements, deleted fragments and identifiers as described above.
21. **Regarding independent claim 20,** Abajian discloses updating metadata fragments included in an electronic document. Abajian recites: "*Promoter 82*

adds, deletes, and/or updates the data (including metadata) associated with a media file in accordance with the requirements of the target search system" (column 14, lines 64-66). Abajian discloses an update version of the metadata. Abajian recites: "Genre annotation comprises updating the genre metadata to ensure proper formatting" (column 12, lines 7-9). Abajian discloses an identifier and deleting as described above.

22. **Regarding claims 22-62 and 64-70,** the claims are directed toward a method for the method of claims 12-15 and 20, and are rejected using the same rationale.

Conclusion

23. The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

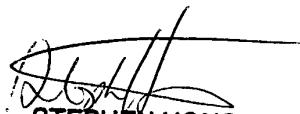
<u>Patent</u>	<u>Date</u>	<u>Inventor</u>
• US-5,892,900 A	04-1999	Ginter et al.
• US-6,185,329 B1	02-2001	Zhang et al.
• US-6,473,794 B1	10-2002	Guheen et al.
• US-6,675,267 B2	01-2004	Rovati, Fabrizio
• US-6,760,746 B1	07-2004	Schneider, Eric
• US-6,847,977 B2	01-2005	Abajian, Aram Christian
• US-6,873,693 B1	03-2005	Langseth et al.
• US-6,877,002 B2	04-2005	Prince, John
• US-6,941,300 B2	09-2005	Jensen-Grey, Sean S

24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Vaughn whose telephone

number is (571) 272-4131. The examiner can normally be reached Monday to Friday from 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen S. Hong can be reached at (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



STEPHEN HONG
SUPERVISORY PATENT EXAMINER

Gregory J. Vaughn
March 16, 2006